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10/566,717	02/01/2006	Roberto Conti	02334900314	8962
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ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER GERRITY, STEPHEN FRANCIS	
			ART UNIT	PAPER NUMBER
			3721	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/566,717	Applicant(s) CONTI, ROBERTO	
	Examiner Stephen F. Gerrity	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-18 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,12-18 and 20-30 is/are rejected.
- 7) ☒ Claim(s) 7-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1 and 14 are objected to because:
 - in claim 1, line 9, "paper" should be changed to --material-- for consistency of terminology; and
 - in claim 14, line 2, "comprises" should be changed to --each comprise--.Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14-18 and 20-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "the working station" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites the limitation "the station for making the counter-impression" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is suggested that claim 28 be amended to depend from claim 15 as opposed to claim 21 wherein the "station for making the counter-impression" is introduced.

These and any other informalities should be corrected so that the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-5, 7, 12-14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rossi (**US 4,747,250**).

The Rossi reference discloses a method for making pods of filter material containing products for infusion including forming a dose of the product as seen in fig. 3 where a delivery system (130) feeds product to mold (64) of disc (120). The measure of product within the mold (64) is formed into a compressed disk of product by a tamper (74). The tamper (74) is discloses as compressing by the action of translating and rotating a forming piston. The compressed disk of product is delivered to between the two webs of filter material which are thermosealed together using member (140), they may later be sheared into individual pods (see col. 4, line 25 through col. 5, line 40).

Regarding claim 14, the Rossi reference discloses an apparatus including an endless belt (10) trained around a pair of sheaves (14, 16) and having a perforated surface (12), and below which is provided a means for creating a vacuum (152) at least at the working station of the belt which feeds the first portion of filter material and on which the product disk is deposited (the “means+function” limitation is equivalently met by the structure in Rossi).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossi (**US 4,747,250**) in view of Salfisberg (**US 2,472,440**).

The Rossi reference discloses a method of making pods which meets all of applicant's claimed subject matter with the exception of making in the second portion of filter material a counterimpression shaped to match the disk and designed to be placed over the disk. In Rossi, the upper web 52 is placed over the disk of product without a counterimpression shape being preformed in the web. The Salfisberg reference discloses a similar type of method for making pods of products of infusion including providing a first filter paper web (11) and a second filter paper web (12). The product is delivered to the first web (11) and the second filter web (12) is then positioned over the first web containing the product. It is noted that both the first and second filter webs (11, 12) have a counterimpression preformed therein by the use of suction channels (14) formed in the rotating drums (6, 9) which draw the web material (11, 12) into recesses (8) formed in each of the drums (6, 9). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Rossi by having made in the second portion of filter material a counterimpression shaped to match the disk and designed to be placed over the disk, as suggested by

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Salfisberg, in order to have a measured quantity of the substance thus deposited held firmly in the cup-like recess and in contact with the packaging strip by the suction (see col. 3, lines 35-40 of Salfisberg).

8. Claims 18 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossi (**US 4,747,250**) in view of Kenney et al. (**US 5,233,813**).

Regarding claim 18, the Rossi device does not disclose a further station for separating the pod from the waste material which is collected in a recovery station. The Kenney et al. reference discloses a similar type of apparatus including a station (15) which is used to recover the waste material separated from the completed pods (see fig. 2). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Rossi device to have had a further station for separating the pod from the waste material which is collected in a recovery station, as taught by Kenney et al., because it is known to a person having ordinary skill in the art to combine elements of one device with another when the results from the combination are predictable.

Regarding claim 30, the Rossi device does not disclose the cutoff station includes a circular knife and a counter-knife. The Kenney et al. reference discloses a similar type of apparatus including a cutoff station that includes a circular knife (35, 37) and a counter-knife (36 - see col. 5, lines 30-52). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Rossi device to have had the cutoff station include a circular knife and a counter-knife, as taught by Kenney et al., because it is known to a person having

ordinary skill in the art to combine elements of one device with another when the results from the combination are predictable.

9. Claims 14, 16, 20-24, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romagnoli (**US 4,437,294**) in view of Rossi (**US 4,747,250**).

The Romagnoli reference discloses an apparatus for making pods of filter material containing infusion products which meets all of applicant's claimed subject matter with the exception of a first endless belt trained around a pair of sheaves and having a perforated or porous surface, and means for creating a vacuum at least at the working station of the first belt which feeds the first portion of the filter material and on which the product disk is deposited. The Rossi reference discloses an apparatus (as discussed earlier in this Office action) including an endless belt (10) trained around a pair of sheaves (14, 16) and having a perforated surface (12), and below which is provided a means for creating a vacuum (152) at least at the working station of the belt which feeds the first portion of filter material and on which the product disk is deposited (the "means+function" limitation is equivalently met by the structure in Rossi). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Romagnoli device to have included a first endless belt trained around a pair of sheaves and having a perforated or porous surface, and means for creating a vacuum at least at the working station of the first belt which feeds the first portion of the filter material and on which the product disk is deposited, as taught by Rossi, in order to hold the material and product stably in place and to remove dust from around the area to be sealed, and because it is known to a

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person having ordinary skill in the art to combine elements of one device with another when the results from the combination are predictable.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Romagnoli (**US 4,437,294**) in view of Salfisberg (**US 2,472,440**).

The Romagnoli reference discloses a method of making pods which meets all of applicant's claimed subject matter with the exception of making in the second portion of filter material a counterimpression shaped to match the disk and designed to be placed over the disk. In Romagnoli, the upper web is placed over the disk of product without a counterimpression shape being preformed in the web. The Salfisberg reference discloses a similar type of method for making pods of products of infusion including providing a first filter paper web (11) and a second filter paper web (12). The product is delivered to the first web (11) and the second filter web (12) is then positioned over the first web containing the product. It is noted that both the first and second filter webs (11, 12) have a counterimpression preformed therein by the use of suction channels (14) formed in the rotating drums (6, 9) which draw the web material (11, 12) into recesses (8) formed in each of the drums (6, 9). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Romagnoli by having made in the second portion of filter material a counterimpression shaped to match the disk and designed to be placed over the disk, as suggested by Salfisberg, in order to have a measured quantity of the substance thus deposited held firmly in the cup-like recess and in contact with the packaging strip by the suction (see col. 3, lines 35-40 of Salfisberg).

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11. Claims 17, 18 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romagnoli (**US 4,437,294**) in view of Kenney et al. (**US 5,233,813**).

Regarding claim 17, the Romagnoli device does not disclose a station for cutting off the disk encapsulated in the two portions of filter material to form a pod. The Kenney et al. reference discloses a similar type of apparatus including station including a cutting knife (35, 37) provided to separate one pod from another. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Romagnoli device to have had a cutting knife for separating one pod from another, as taught by Kenney et al., in order to separate the pods from one another for further handling and eventual use by a consumer, and because it is known to a person having ordinary skill in the art to combine elements of one device with another when the results from the combination are predictable.

Regarding claim 18, the Romagnoli device does not disclose a further station for separating the pod from the waste material which is collected in a recovery station. The Kenney et al. reference discloses a similar type of apparatus including a station (15) which is used to recover the waste material separated from the completed pods (see fig. 2). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Rossi device to have had a further station for separating the pod from the waste material which is collected in a recovery station, as taught by Kenney et al., because it is known to a person having ordinary skill in the art to combine elements of one device with another when the results from the combination are predictable.

Regarding claim 30, the Rossi device does not disclose the cutoff station includes a circular knife and a counter-knife. The Kenney et al. reference discloses a similar type of apparatus including a cutoff station that includes a circular knife (35, 37) and a counter-knife (36 - see col. 5, lines 30-52). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Rossi device to have had the cutoff station include a circular knife and a counter-knife, as taught by Kenney et al., because it is known to a person having ordinary skill in the art to combine elements of one device with another when the results from the combination are predictable.

Allowable Subject Matter

12. Claims 25, 28 and 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. Claims 7-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter.

Claim 7, and its dependent claims 8 and 9, are considered allowable because claim 7 requires that the depositing and compressing occur, respectively, while moving along a first defined path of the forming station and a second defined path following the first path.

The combination set forth in claim 7 defines over the prior art because it would not have been obvious to a person having ordinary skill in the art to have modified the Rossi (**US 4,747,250**) method to have arrived at the claimed subject matter because the Rossi reference uses a step-wise process of moving the disc 120, and the molds are stationary during the depositing and compressing steps (see paragraph bridging columns 4 and 5). Additionally, while such is known per-se in the prior art, see for instance Romagnoli (**US 4,437,294**), it would not have been obvious to have modified the Romagnoli method to have included a translating and rotating piston, for instance as suggested by Rossi '250. Any such combination would be based on impermissible hindsight, and more importantly the results of such a combination would not have lead a person having ordinary skill in the art to assume the results of such a combination would be predictable or expected.

Claims 10 and 11 are each allowable because the claimed combination requires the limitation that the depositing step is accomplished by allowing the compressed disk of product to drop out of a respective impression by gravity onto the first portion of the filter material. The combination set forth in each of claims 10 and 11 is not anticipated by or obvious over the prior art.

Response to Arguments

15. Applicant's arguments with respect to claims 1, 3-18 and 20-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached form (PTO-892) are cited to show various machines and methods for making pods. All are cited as being of interest and to show the state of the prior art.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is 571-272-4460. The examiner can normally be reached on Monday - Friday from 6:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen F. Gerrity/
Primary Examiner
Art Unit 3721

8 October 2007